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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1953.

No. 228

**EMANUEL L. MAZER AND WILLIAM ENDICTER,
DOING BUSINESS AS JUNE LAMP MANUFACTUR-
ING COMPANY,**

Petitioners,

vs.

**BENJAMIN STEIN AND RENA STEIN, DOING BUSI-
NESS AS REGLOE OF CALIFORNIA**

Respondents.

Brief for Respondents

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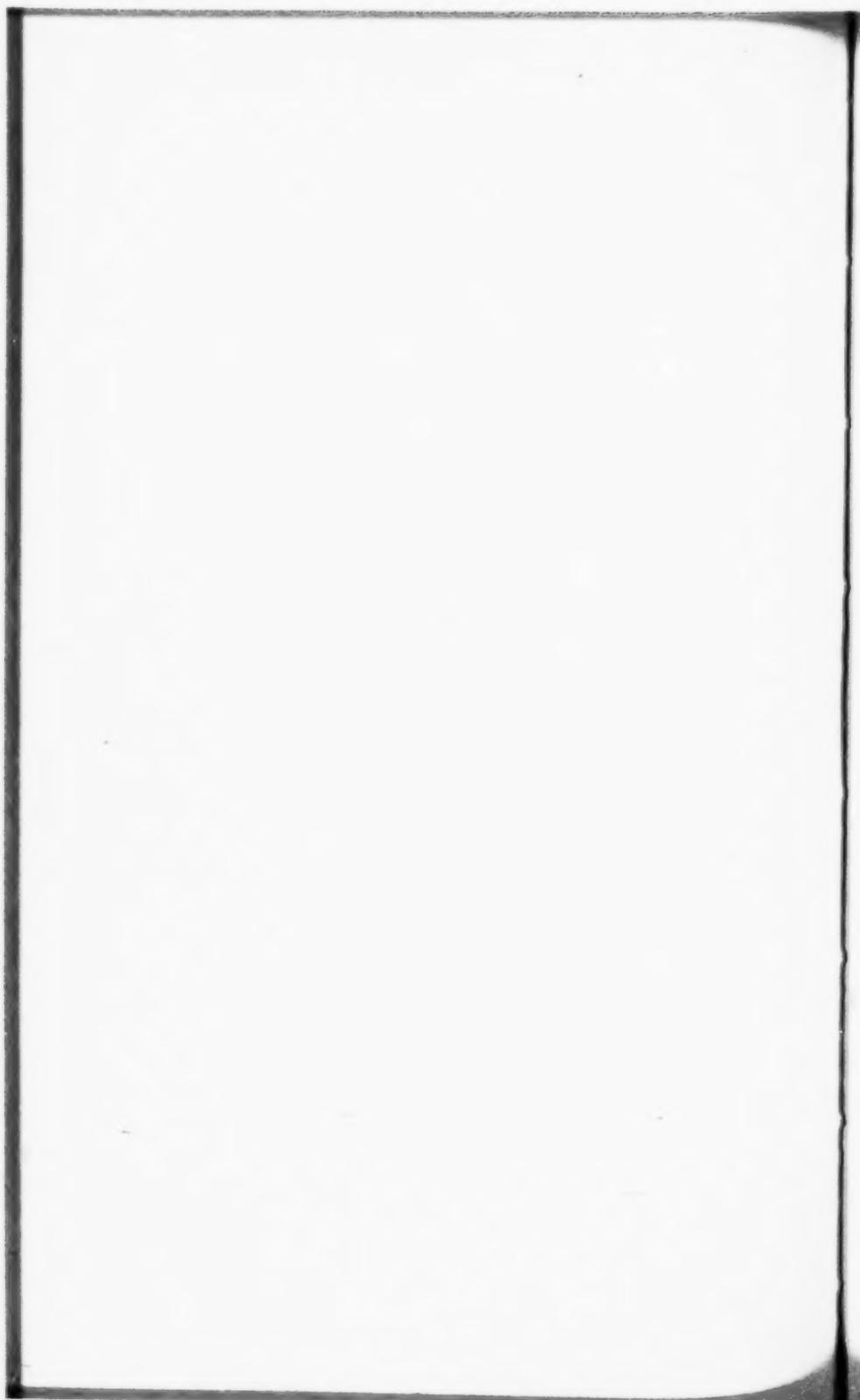


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Brief for Respondents

OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit (R. 70) is reported at 204 F(2d) 472. The opinion of the District Court (R. 57) is reported at 111 Fed. Supp. 359.

JURISDICTION

The Court has jurisdiction under Title 28, United States Code, Section 1254.

QUESTION PRESENTED

Whether the copyright in a statue as a "work of art" is infringed by a lamp embodying a copy of the statue when:

1. The statue was created in standard art form by the application of traditional clay modeling and waste mold sculpturing technique by an artist intending to profit from all applications of the work, and
2. The statue was copied and used as the base portion of the lamp to display conspicuously all the art of the statue.

STATUTES INVOLVED

1. Title 17, United States Code (Copyrights):

Section 1. Exclusive Rights as to Copyrighted Works.

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

- (a) To print, reprint, publish, copy, and vend the copyrighted work;

* * * * *

Section 5. Classification of Works for Registration.

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

* * * * *

- (g) Works of art; models or designs for works of art.

- (h) Reproductions of a work of art.

* * * * *

The above specifications shall not be held to limit the subject matter of copyright as defined in

section 4 of this title, nor shall any error in classification invalidate or impair the copyright protection secured under this title.

Section 207. Rules for Registration of Claims.

Subject to the approval of the Librarian of Congress, the Register of Copyrights shall be authorized to make rules and regulations for the registration of claims to copyright as provided by this title.

2. Rules and Regulations of the Copyright Office:

Section 202.8 Works of Art (Class G)

(a) *In general.* This class includes works of artistic craftsmanship in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. * * *

(37 C.F.R. 1949 ed. 202.8)

3. Title 35, United States Code (Patents):

Section 154. Contents and Term of Patent

Every patent shall contain * * * a grant to the patentee * * * of the right to exclude others from making, using, or selling the invention * * *.

Section 171. Patents for Designs

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor * * *.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

STATEMENT OF THE FACTS

This is an action for copyright infringement seeking injunctive relief and damages. The copyrights in issue were granted on applications specifying class h "Reproductions of a work of art" (Plf. Ex. 1-6, R. 31-37).

The copyright certificates were issued after deposit by Respondents of physical statues as specimens of each work (R. 15, 21). Copies of the deposits are in evidence as Plaintiffs' Exhibits 1A to 6A, inclusive. A specimen withdrawn from the files of the Copyright Office is in evidence as Plaintiffs' Exhibit 8 (R. 28-29).

The subjects of the works are dancing human figures. Each was executed by preparing a number of rough sketches, a composite drawing from the sketches, and then modeling the figure in clay over an armature, using the drawing as a guide (R. 21). The clay model in each instance was then used to prepare a waste mold and the rubber production mold made from the latter (R. 21).

The statutes here involved are part of a line of some 90 separate forms which Respondents make and sell (Plf. Ex. 12, R. 40B (see original exhibit), R. 19). It is the policy of Respondents to sculpture every piece as an original work (R. 19). The line was started in 1947 and differed from the static pieces then available in incorporating a fluidity of movement (R. 19). Respondents stress originality and freshness and make an effort to confine their products to innovations and fine sculpture (R. 19).

Respondents sell the statues in two forms. In one form, a lamp socket and shade are added to provide a complete lamp of which the statue forms the base portion (Plf. Ex. 12, R. 40B). Respondents principal financial return is de-

rived from sales in this form (R. 10-14). The statues are also sold without additional parts, although the sales in this form are relatively small in number (Plf. Ex. 12, R. 40A, R. 10-14). It is estimated that for the line as a whole a total of 200 statues have been sold without lamp parts (R. 22). Respondents have never refused to sell a statue without lamp parts added (R. 23).

The accused infringements are in evidence as Plaintiffs 1B to 6B, inclusive (R. 17). These are lamps, the bases of which are in every material respect identical with the original statues filed in the Copyright Office by the Respondents. Every element of art in the copyrighted work is displayed in the lamp form sold by Petitioners (Plf. Ex. 15, R. 40C).

Petitioners do not deny that the accused products are copies of Respondents' copyrighted works. Nor do they contest the finding of the Copyright Office that they are "works of art." The only defense pressed is that Respondents should have obtained design patents instead of copyrights (Brief, pp. 6-7).

The District Court considered the case of *Stein v. Expert Lamp Co.*, 188 F(2d) 611 (C.A. 7, 1951), to be applicable and accordingly gave judgment for Petitioners (R. 60, 66). The Court of Appeals for the Fourth Circuit considered the *Expert* case distinguishable and in any event declined to follow it (R. 80). The Court accordingly gave judgment for Respondents (R. 84).

SUMMARY OF ARGUMENT

The works in suit are statues of dancing human figures, a standard art form (Plf. Ex. 1A to 6A). They were prepared by application of the traditional sketch—clay model—waste mold art technique (R. 21; 20 *Encyclopedia Britannica* 223, 230, 1945 Ed.). Respondents sell the works as simple statues or with lamp socket and shade added to form a lamp (Plf. Ex. 12, R. 40A, R. 22). The copies here accused were sold with lamp socket and shade added, the statues being conspicuously displayed as the base portions of the units (Plf. Ex. 15, R. 40C).

Petitioners' apply a self-created rule that copyright can cover only works incapable of volume reproduction prepared solely to gratify the "supreme egotism" of the sculptor (i.e. Brief, p. 41). This art gallery concept finds no support in the statutes, old or new. Its adoption would also require rejection of the circus poster case where this Court upheld the copyright to a drawing made for a circus poster and reproduced in large quantities for advertising the circus. *Bleistein v. Donaldson*, 188 U.S. 239, 249 (1903).

Sections 5(g) and 5(h) of the Copyright Code (17 U.S.C.) require a "work of art." This language is a deliberate enlargement from the more narrow term "models or designs intended to be perfected as works of the fine arts" used in the law prior to 1909 (R.S. 4952, 16 Stat. 198, 212). The difference between a "work of the fine arts", on the one hand, and a "work of art", on the other hand, lies in the limitation of the former to works created "for their own sake and without relation to the utility of the object produced" whereas the latter encompasses all which is produced "as paintings, sculpture, etc., by the

application of skill and taste" (Webster's New International Dictionary, 1950). The works here surely fulfill the broad standard "works of art". Indeed, they may well be considered works of fine art.

Since at least 1909 it has been the practice of the Copyright Office to grant registrations to works in standard art form although they can be—and are—embodied in some useful object (R. 25-28). This practice is entitled to great weight as a correct application of the law. *U.S. v. Citizens Loan & Trust Co.*, 316 U.S. 209, 214 (1942). The weight to be attached to this practice is further increased by the fact that it existed promptly after passage of the 1909 Copyright Act. *Norwegian Nitrogen Products Co. v. U. S.*, 288 U.S. 294 315 (1933). Its importance is further increased by the fact that it is a practice that has existed for over 40 years. *U. S. v. Schreveport Grain*, 287 U.S. 77, 84 (1932).

The Copyright Code of 1947 (61 Stat. 652) and the Patent Code of 1952 (66 Stat. 792), reenact Section 5 of the 1909 Copyright Act and the 1902 Design Patent Act, respectively, without substantial change. This reenactment of the statutes here involved embodies an adoption by Congress of the construction of the statutes by the Copyright Office. *Helvering v. R. J. Reynolds Tobacco Co.*, 306 U.S. 110, 114-115 (1939).

Nor can monopoly phobia weigh in favor of Petitioners. Rather it supports Respondents. Copyright is merely the sole right to multiply copies. One can always escape the bounds of a copyright by creating an original work, however similar it may be to the copyrighted work. *Bleistein v. Donaldson*, 188 U.S. 239, 249 (1903). In contrast, design patents confer a broad monopoly, good as against subse-

quent creators and not just copyists. Independent creation will not save the design patent infringer. *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F(2d) 99, 103 (C.A. 2, 1951). The procedural and other differences between design patent and copyright merely reflect this fundamental difference in scope.

Any effort to protect the works here by design patent would be a corruption of the Design Patent Law. That law is intended to protect pleasing design which amounts to "invention"—a term inapplicable to statues of the dancing human figure. Indeed, the courts have squarely held that the human figure cannot involve "invention" over the "prior art." *In re Smith*, 77 F(2d) 513, 514 (C.C.P.A., 1935); *Frankart v. Apt Novelty Co.*, 57 F(2d) 757 (S.D.N.Y., 1931). Objects such as the stockings of *Glen Raven v. Sanson*, 189 F(2d) 845, 848 (C.A. 4, 1951)—prepared in the first instance to achieve the useful end and then ornamented to the extent permitted by their purpose—are appropriate for design patent protection. Works in standard art form such as those here involved are clearly inappropriate for such protection.

Respondents are content with the narrow protection against copying provided by the copyrights—they willingly face the competition of non-copyists. Surely they are not seeking too much.

The Court of Appeals for the Fourth Circuit in the present case and the Court of Appeals for the Ninth Circuit in *Rosenthal v. Stein*, 205 F(2d) 633 (June 26, 1953), properly refused to follow *Stein v. Expert Lamp Co.*, 188 F(2d) 611 (C.A. 7, 1951). The *Expert* case should be rejected because the court misinterpreted the regulation of the Copyright Office to mean the opposite of what is in-

tended. The court also wholly overlooked the narrow character of the copyright as compared to the broad patent monopoly which is good even as against subsequent independent creators. The legal commentators have uniformly refused to endorse the *Expert* case. i.e. 27 *Indiana Law Journal*, 130, 134 (1951); 21 *George Washington Law Review*, 353, 366 (1953); 66 *Harvard Law Review*, 877, 884 (1953); 52 *Michigan Law Review*, 33, 64, 68 (1953); Derenberg, Copyright No-Man's Land, (1953) *Copyright Problems Analyzed*, 215, 238, 246. The *Expert* case is also distinguishable on the facts.

The judgment should be affirmed.

ARGUMENT.

A.

The Statues Here Are "Works of Art" Within the Meaning of the Copyright Code and the Copyright Office Properly So Found.

1. *The works here are statues of the human figure in action prepared by traditional art technique.*—Physical specimens of the works are in evidence as Plaintiff's Exhibits 1A-6A and 8. Each portrays a dancing human figure. The figures were executed by preparing a number of rough sketches, a composite drawing, and then modeling in clay over an armature using the drawing as a guide (R. 21). The clay model thus made was then used to make the waste mold from which the rubber production mold was formed (R. 21). This process is described in *Encyclopedia Britannica* under the title "Sculpture Technique" (Vol. 20, p. 217 et. seq., especially pp. 223 and 230, 1945 Ed.).

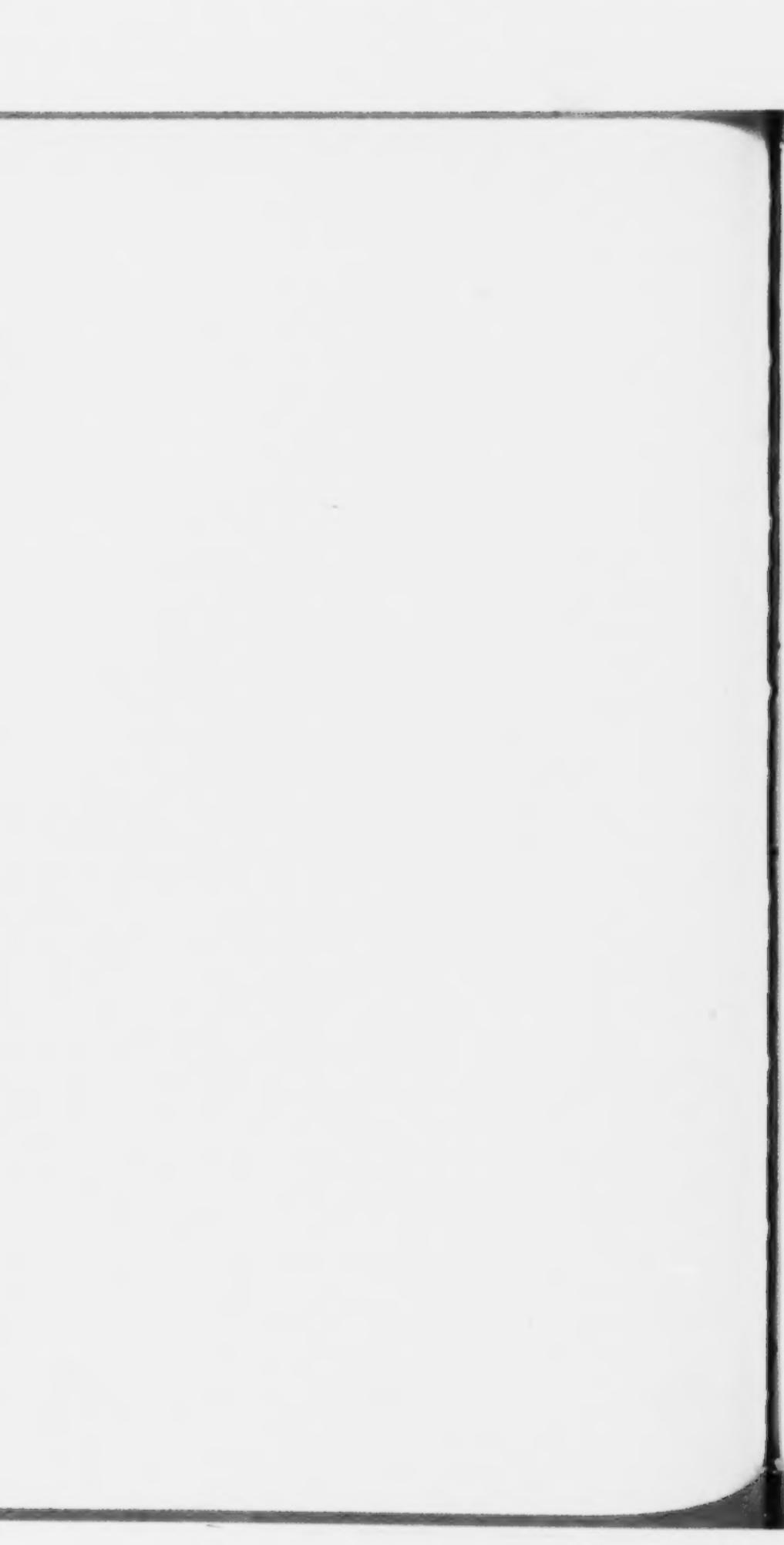
Plainly these are "works of art" as that term is used in Section 5(g) and 5(h) of the Copyright Code (17 U.S.C. 5). The works are sculpture, a standard art form. They portray the human figure, a traditional subject of sculpture. They are prepared by recognized art technique. The Copyright Office examined the physical specimens submitted and found them to be works of art under the statute (R. 29). The human figure statues of the present case are identical in character with the dog figure statue held infringed in *Woolworth v. Contemporary Arts*, 193 F(2d) 162 (C.A. 1, 1951) (Affirmed on issue of damages at 344 U.S. 228).

Respondents specified class (h) because the works here are three-dimensional reproductions of the unpublished



The Works Here Registered Are Sculpture, a Standard Art Form. They Were Prepared by Traditional Art Technique. By Any Test They Are "Works of Art". Like Any Physical Objects—and Any Work of Art—They Can Be Used for Paper Weights, Lamps, and the Like, Without Altering the Artistic Display,

(Picture shows Plaintiffs' Exhibit 8)



sketches originally prepared by Mrs. Stein. The Register of Copyrights has testified that the policies and practices of the Copyright Office are the same for class (h) and class (g) (R. 30).

The statues involved in this cause should be contrasted with "industrial designs" such as the stocking of *Glen Raven v. Sanson*, 189 F(2d) 845, 848 (C.A. 4, 1951), which are prepared and shaped in the first instance to attain a useful end. Pleasing appearance is then imparted to such products in an endeavor to attain maximum ornamentation compatible with the intended purpose and reasonable cost. No recognized art form is sought for or obtained.* No traditional art technique is applied. Such objects—whose design is dictated primarily by purpose and whose ornamentation is always secondary to that purpose—form the major area of operation of the Design Patent Law.

2. *Statues are not disqualified from copyright protection because they can be and are incorporated in objects produced for sale.*—Like all statuary the works here can be used and sold as paper weights, door stops, and the like, and parts can be added to form lamps, book ends, and similar objects, all without altering the artistic display. Indeed, the works here are sold in greatest number in the form having lamp socket and shade added, a form in which they are sold by both Respondents and Petitioners (R. 22, 17). Respondents also sell the works in the simple statue form (Plf. Ex. 12, R. 40A, R. 22). These varied ap-

* We use the term "standard art form" or "recognized art form" to designate artistic expression in painting drawings or sculpture as distinguished from artistic jewelry and the like which may embody artistic craftsmanship not expressed in one of these basic forms. The present record presents no issue as to the status of works in other than standard art form.

plications are inherent in any sculpture, including that of the copyrighted dog statue of *Woolworth v. Contemporary Arts*, 193 F(2d) 162 (C.A. 1, 1951) (aff'd. on damages, 334 U.S. 228). To disqualify any sculpture from copyright because it can be applied to such objects is to disqualify all sculpture.

a. *This Court has squarely rejected the argument that commercial reproduction or intent to commercialize is fatal to copyright.*—In *Bleistein v. Donaldson*, 188 U.S. 239 (1903), the work involved was a circus poster of the usual type, showing scenes performed in the circus. The Circuit Court of Appeals held the copyright invalid because “if a chromo, lithograph, or other print, engraving or picture has no other use than that of a mere advertisement, and no value aside from this function, it would not be promotive of useful arts * * *” (104 Fed. 993, 996). Justice Holmes, rejecting this view and speaking for this Court, stated in part:

“* * * A picture is none the less a picture, and none the less a subject of copyright, that it is used for an advertisement. And if pictures may be used to advertise soap, or the theatre, or monthly magazines, as they are, they may be used to advertise a circus. Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.” (188 U.S. 239, 251)

This Court also rejected any test based on the intent of the artist, stating that “the special adaptation of these pictures to the advertisement of the Wallace shows does not prevent a copyright” (188 U.S. 239, 251).

The same yardstick that dictates the conclusion that a circus poster is copyrightable requires the conclusion that a statue finding a market as the distinctive part of a lamp assembly is likewise copyrightable. Indeed, the logic applies in double measure for the *Bleistein* decision was under a statute using the expression "works of fine art" whereas the present case involves the broader expression "works of art" introduced into the Copyright Law in 1909 (188 U.S. 239, 250).

Petitioners overlook the healthy rule of this case in laying down supposed rules that copyright demands a "cultural treasure" (p. 9) that "cannot be duplicated by mechanical means" (p. 10) and prepared by a "real artist (who) pleases and expresses only himself and in his supreme egotism wants to leave only one of a work to posterity rather than a brood of one work to a contemporary public" (p. 41). Indeed, Justice Holmes specifically put arguments of this kind to rest by stating that "if they command the interest of any public, they have a commercial value,—it would be bold to say that they have not an aesthetic and educational value,—and the taste of any public is not to be treated with contempt." (188 U.S. 239, 252).

The soundness of both the *Bleistein* decision and the practice of the Copyright Office is demonstrated by the widespread use of works of art in useful objects. Rodin's "Thinker" is undeniably a "work of art". Yet it is a matter of common knowledge that this work can—and has—been used on book ends. Surely, Congress never in-

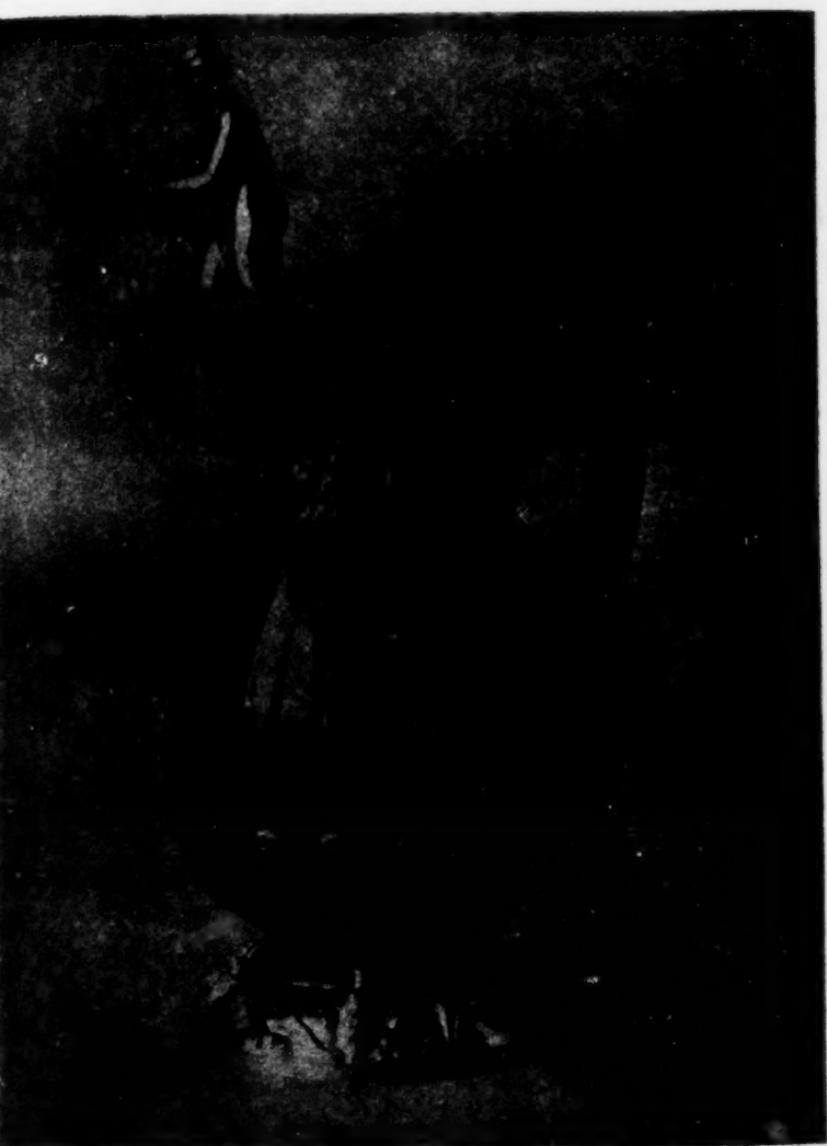
tcnded to deprive works of this kind of copyright protection.

Art objects having direct usefulness form a great class of artistic expression. Cellini's celebrated salt cellar—useful and intended to be useful—stands as one of his major works (5 Encyclopedia Britannica, p. 97, 1945 Ed.). Artistic incense burners, mugs, cups, plates, candle holders, and the like find a place in every art gallery as shown by the illustrations attached.* Petitioners would deprive all of this truly great art of access to the Copyright Law and, even if copyrighted in some nonuseful form, they would deny the protection of the copyright to a complete appropriation and display of the art in a useful product.

The principle of the *Bleistein* case has been followed by numerous more recent decisions including: *King Features v. Fleisher*, 299 Fed. 533, 535 (C.C.A. 2, 1924) (copyrighted "Barney Google" cartoons infringed by doll reproduction); *Fleisher v. Freundlich*, 73 F(2d) 276, 278 (C.C.A. 2, 1934) (copyrighted "Betty Boop" cartoons infringed by doll reproduction—copyright owner engaged in the manufacture of the dolls through a licensee); *Pelligrini v. Allegrini*, 2 F(2d) 610 (E.D.Pa., 1924) (copyrighted religious candle holder infringed by copy sold commercially); *Jones v. Underkoffler*, 16 Fed. Supp. 729, 730-732 (M.D.Pa., 1936) (copyrighted cemetery memorial infringed by cemetery use of copy).

b. *The legislative history of the Copyright Law and the Design Patent Law reveals a Congressional intent to afford copyright coverage to statues irrespective of possible or actual application to useful products.*—In the Consolidated

* Illustrations taken from pamphlet entitled "Art Treasures from the Vienna Collections", copy deposited with the Clerk. Hundreds of other books might equally well have been chosen.



NO. 211. JASPER TANKARD. EARLY XVII CENTURY

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Patent, Trademark, and Copyright Act of 1870 (16 Stat. 198) statutes were expressly listed under both the Copyright Law and the Design Patent Law. The Copyright Law used the expression "statue, statuary, and of models or designs intended to be perfected as works of the fine arts" (Section 86). The Design Patent Law used the expression "original design for a manufacture, bust, statue, alto-relievo, or bas-relief" (Section 71). The coordinate plan of this statute continued until 1902 and 1909 when the Design Patent Law and the Copyright Law, respectively, were changed. Under this plan statuary was specifically listed under both the Copyright Law and the Design Patent Law, although the language of the former indicated some intention to confine copyright to the "fine arts."**

Congress emphasized the distinction between fine art and art in general in the Copyright Act of June 18, 1874 (18 Stat. 78), using the following language:

"* * * the words 'engraving', 'cut' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright laws, but may be registered in the Patent Office. * * *"

The Design Patent Law was changed to essentially its present form in 1902 (32 Stat. 193). Since that date this law has referred only to "ornamental design for an article of manufacture" and has not referred to statuary as such (35 U.S.C. 171).

* Nothing in the 1870 statute disqualified a work, otherwise copyrightable, from registration merely because made in quantity or subject to useful applications. The act of August 1, 1882 (22 Stat. 181) shows that Congress never intended any such limitation for it states that "manufacturers of designs for molded decorative articles, tiles, plaques, or articles of pottery or metal subject to copyright may put the copyright mark * * * upon the back or bottom of such articles * * *"

The Copyright Law was expanded in 1909 to list "Works of art; models or designs for works of art" (35 Stat. 1076). All reference to the intent of the artist or to works of the "fine arts" was deleted. At the hearings on this Act, the Librarian of Congress testified:

"* * * the term 'work of art' is deliberately intended as a broader specification than 'works of the fine arts' in the present statute with the idea that there is subject matter (for instance, of applied design, not yet within the province of design patents), which may properly be entitled to protection under the Copyright Law." (Testimony of Mr. Herbert Putnam, Librarian of Congress, before the Committee of Patents of the House of Representatives on June 6, 1906, p. 11.)

The works here surely come within the broad term "art" which is:

"* * * 10. That which is produced, as paintings, sculpture, etc. by the application of skill and taste. * * *" (Webster's New International Dictionary, 1950.)

Indeed, they may well be classified as "fine art" which has been defined as:

"Art which is concerned with the creation of objects of imagination and taste for their own sake and without relation to the utility of the object produced." (Webster's New International Dictionary, 1950.)

Petitioners seem to construe the parenthetical remark of Mr. Putnam as limiting the expanded area of the 1909 Copyright Act to "applied design, not yet within the province of design patents" (Brief, p. 24). As a matter of plain English, Mr. Putnam was merely giving an example—not a limitation—for he carefully prefaced his statement with the qualification "for instance". Moreover, even if we assume *arguendo* that Mr. Putnam used this

expression in a limiting sense and further that the Act is so limited, the statues here are clearly registrable for they are of the human figure in action—a subject that has been repeatedly held incapable of “invention” over the “prior art” as required for design patent. *In re Smith*, 77 F(2d) 513, 514 (C.C.P.A., 1935); *In re Smith*, 77 F (2d) 514, 515 (C.C.P.A., 1935); *Frankart v. Apt Novelty Co.*, 57 F(2d) 757 (S.D.N.Y., 1931). Indeed it is the artistic character of the works and their expression in a classical art form that makes the whole concept of “invention” over the “prior art” utterly inappropriate.

c. *The Copyright Office has for many years registered statues like those here in suit.*—In his deposition in this case the present Register of Copyrights testified:

“The practice of the copyright office is to register claims for copyrights in any work which in our opinion is a work of art, even though such work has a mechanical or utilitarian aspect. Such works must be the product of artistic craftsmanship and may include works of art such as those used for bookends, ash trays, piggy banks and so forth.” (R. 25)

At a later point he stated:

“Again, we frequently will receive applications for the registration of paintings on plates, for example. We register the painting on the plate but we are not concerned with the fact that the material upon which the painting is made may be intended as an article of utility for the handling of food. In other words the practice of the office with respect to this phrase about which I am asked is not to undertake to register or deal with the mechanical or utilitarian aspects, but exclusively to determine whether the work that is submitted to us is a work of art and we disregard the question of whether it has in addition a mechanical or utilitarian function.” (R. 27)

Nor is this practice one of recent origin. The Register testified that it was well established in 1946 (R. 25) and that it is his understanding that the practice developed after the 1909 enlargement of the Copyright Law to the broad term "works of art" (R. 27-28).

This practice of the Copyright Office is entitled to great weight as a correct application of the law. *U.S. v. Citizens Loan & Trust Co.*, 316 U.S. 209, 214 (1942); *Norwegian Nitrogen Products Co. v. U.S.*, 288 U.S. 294, 315 (1933). Particularly, is this true when the practice was in existence promptly after passage of the 1909 Copyright Act. *Norwegian Nitrogen Products Co. v. U.S.*, 288 U.S. 294, 315 (1933). Its importance is further increased by the fact that it is a practice that has existed for over 40 years. *U.S. v. Schreveport Grain*, 287 U.S. 77, 84 (1932).

Moreover, Section 5 of the 1909 Copyright Act was re-enacted without change in the Copyright Code of 1947—almost 40 years after the practice here in question arose (61 Stat. 652). The implied Congressional approval of the practice is made complete by the enactment of the Patent Code of 1952, which reenacted the Design Patent Law without substantial change (66 Stat. 792, 35 U.S.C. 171). This Court has repeatedly held that reenactment of a statute "which had previously received long continued executive construction, is an adoption by Congress of such construction". *U.S. v. Cerecedo Hermanos*, 209 U.S. 337, 339 (1908); *U.S. v. Dakota-Montana Oil Co.*, 288 U.S. 459, 466 (1933); *Helvering v. R. J. Reynolds Tobacco Co.*, 306 U.S. 110, 114-115 (1939).

Petitioners seek comfort in the Copyright Office regulations in effect from 1909 to 1948 (Brief, p. 21). In so doing they misread the regulations. These regulations spelled

out only the extreme cases of "paintings, drawings, and sculpture", which are copyrightable and "productions of the industrial arts, utilitarian in purpose and character, even if artistically made or ornamented", which are not copyrightable (37 CFR 1939 ed. 201.4 (b) (7)). These regulations in no way limited registration of works such as sculpture, which were in standard art form, because they were or could be embodied in useful objects. They merely stated that the Copyright Office would not accept so-called industrial designs, such as the stocking of *Glen Raven v. Sanson*, 189 F(2d) 845, 848 (C.A. 4, 1951), wherein shape is in the first instance dictated by considerations of utility and then pleasing appearance is imparted to the extent it is consistent with the purpose to be served. The present works obviously fall in the first class and not the second, a fact that squares with the testimony that the works would be registrable under the practice existing since at least 1909 (R. 25-28).

In 1948 the Copyright regulations were rewritten in language intended to fill the gap between the extremes set forth in the earlier regulation. As rephrased, the regulation here applicable reads:

"* * * This class includes works of artistic craftsmanship, in so far as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as all works belonging to the fine arts, such as paintings, drawings and sculpture. * * *" (37 CFR 1949 ed. 202.8)

Under this new regulation the Copyright Office registers works, such as artistic jewelry, which are works of art and yet are not expressed in a standard art form as statuary. Considerable publicity attended promulgation of this new regulation, both by reason of its official publication in the

Federal Register and by reason of contemporaneous articles such as that prepared by the then Register, Mr. Sam B. Warner, reproduced as the Appendix to Petitioners' brief (Jewelers Circular-Keystone, September 1948; reprinted at 31 Jl. Pat. Off. Society 487 (1949); and see Hugin, Copyrighting Works of Art, 31 Jl. Pat. Off. Society 710 (1949)).

Of course the new regulation did not alter the copyrightability of works such as those of this case which are in a standard art form such as sculpture. These works were registrable under the prior practice and without regard to the question of whether they were or could be applied to useful objects (R. 25-28). Mr. Warner's article itself so states (Petitioners' Brief App. 8c). The new regulation does, however, have significance in that it emphasized the earlier practice as well as the change. The incident publicity—particularly when followed by reenactment of the Design Patent Law without substantial change in 1952 (66 Stat. 792)—shows that the practice met with the approval of Congress.

Whether we apply the yardstick of the statutory language, the legislative history, the practice of the Copyright Office, or the decided cases, we reach the same conclusion—copyright extends to the market place and applies to statuary irrespective of actual or possible useful application.

B.

Copyright to a Statue as a Work of Art Is Infringed by Sale of Copies of the Statue With Lamp Parts Added.

The crucial aspect of the copies here accused lies in the complete and conspicuous display of each and every element of art in the original statues. Petitioners merely embedded a pipe in the plaster during the molding process

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Plaintiffs' Exhibit 15—Also compare physical exhibits 1A
(original) and 1B (copy)

The Accused Products Copy and Conspicuously Display
Every Artistic Feature of the Copyrighted Originals.

BLEED THROUGH

POOR COPY

and thereafter attached a lamp socket and shade. Plaintiffs' Exhibit 15, an advertisement showing one of Petitioners' products, shows how the lamp shade accents rather than detracts from the full display of the art (R. 40C). Nothing is covered or hidden. The art is dominant. Since the copies embody the entire work of art—and the copyright is granted to the "work of art"—there is infringement.

In *King Features v. Fleisher*, 299 Fed. 533 (C.C.A. 2, 1924), the court stated:

"The statuary, made of materials, expressed the sculptor's concept of beauty, and the picture expresses the artist's concept of beauty. The concept of beauty expressed in the materials of the statuary or drawing, is the thing which is copyrighted. That is what the infringer copies. The Copyright Act was intended to prohibit the taking of this conception. The Copyright Act protects the conception of humor which a cartoonist may produce, as well as the conception of genius which an artist or sculptor may use." (299 Fed. 533, 536)

In that case the court held the copyrights to the "Barney Google and Spark Plug" cartoons infringed by three dimensional doll copies. In *Fleisher v. Freundlich*, 73 F(2d) 276 (C.C.A. 2, 1934), the court reached the same result in a case involving the "Betty Boop" cartoons. There the copyright proprietor, through a licensee, distributed thousands of toys and dolls like the accused copies in addition to publication of the cartoon form of the character. See also *Hill v. Whalen*, 220 Fed. 359 (S.D.N.Y., 1914) (dramatic performance by actors dressed as "Mutt" and "Jeff" an infringement of copyrighted cartoons).

The Courts of Appeal for the Fourth Circuit and the Ninth Circuit have correctly looked to identity of artistic

concept to hold the copies of the statues embodied in lamps as infringements of Respondents' copyrighted statues.

C.

Monopoly Phobia Should Not Defeat the Plain Meaning of the Copyright Code, Particularly Since the Issue Is Between Narrow Copyright Protection and Broad Patent Protection.

1. *Copyright extends only to actual copies of the work involved.*—The modern copyright law—as did its antecedents—turns on the element of copying. Absent copying, there can be no infringement of copyright. *Bleistein v. Donaldson*, 188 U.S. 239, 249 (1903); *Arnstein v. Porter*, 154 F(2d) 464, 468-9 (C.C.A. 2, 1946). It has been aptly stated that a copyright merely gives “the sole right of multiplying copies.” *Jeweler’s Circulating v. Keystone Publishing*, 281 Fed. 83, 94 (C.C.A. 2, 1922). Copyright is accordingly a very narrow thing. Others are free to create the identical work—provided only that they abstain from copying.

This limitation on the scope of copyright is of vital commercial importance. One need only to look to the lower court opinions in the *Woolworth* case to see the heavy practical burden placed on the copyrightee and the strong defense weapon available to the accused infringer. *Contemporary Arts v. Woolworth*, 93 Fed. Supp. 739 (D. Mass., 1950); *Woolworth v. Contemporary Arts*, 193 F(2d) 162, 165-167 (C.A. 1, 1951). Surely, Petitioners do not seriously suggest that the courts either ignore or minimize this burden faced by every copyright plaintiff (Brief, p. 18).

We would not be before this Court if the Petitioners had created their own works. We invite them to do this and will face their competition when and if they do their

own creating. The fact is that the minute identities or "fingerprints" traceable from Respondents' originals to the accused copies are so condemning that no defense of this kind has been pressed.

2. *Patent gives a monopoly even as against independent creators.*—In keeping with its derivation from the law of patents for technical inventions, design patent gives a true monopoly. Protection is not limited to copying. It is wholly irrelevant that the accused infringer in fact independently made the design patented. The public is wholly deprived of any access to the patented subject for the full term of the grant. The economic consequences of this unlimited monopoly as against independent inventors are necessarily great for it cuts off their opportunity *even to use their own creations.*

This broad reach of the patent grant is plain from the statute itself. The relevant portion of Section 154 of the Patent Code (Title 35, U.S.C.) provides that "Every patent shall contain * * * a grant to the patentee * * * of the right to exclude others from making, using, or selling the invention throughout the United States * * *". cf: 35 U.S.C. 171 and 173. The courts have consistently stated that the accused infringer cannot escape because he is himself an independent inventor. *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F(2d) 99, 103 (C.A. 2, 1951). This Court in effect rejected the same defense in *Gorham v. White*, 14 Wall. 511, 528-31 (1871) where it looked to general similarity and refused to hold the design patent limited to copies that might have been "struck from the same die".

In *Bobbs-Merrill v. Straus*, 210 U.S. 339, 343-51 (1908) this Court very carefully pointed out the distinction be-

tween the limited "copy" protection associated with copyright and the broad patent monopoly good against subsequent creators. There the plaintiff relied upon an asserted analogy between patent and copyright in an attempt to justify resale price maintenance of a copyrighted book. In rejecting the analogy, this Court quoted the following with approval:

" 'There are such wide differences between the right of multiplying and vending copies of a production protected by the copyright statute and the rights secured to an inventor under the patent statutes, that the cases which relate to one subject are not altogether controlling as to the other' " (210 U.S. 346)

3. *Congress has logically provided unlike procedures for these unlike grants.*—Indeed, in view of the fundamental differences between scope of protection it would be most peculiar not to find different procedures in the Copyright Office and the Patent Office and different terms of the grants. Copyright—being effective only as against copyists—does not turn upon what other independent creators have done. It is confined to intellectual forgery. Originality of the author is the key to the grant as well as a complete defense to an infringement charge. Prior art or "anticipation" is utterly irrelevant. *Alfred Bell v. Catalda Fine Arts*, 191 F(2d) 99, 103 (C.A. 2, 1951). The law accordingly requires only the presence of original art and a determination by the Copyright Office that there is art. 17 U.S.C. 5(g); 17 U.S.C. 11.

The Copyright Office is fully conscious of its duty to register only that which qualifies as a "work of art". The Register of Copyrights has testified that such examination was made in the present case and that the Office found the requisite art (R. 28-29). An illustrative court

decision resulting from the exercise of this examining power is found in *Brown v. Warner*, 161 F(2d) 910 (App. D.C., 1947). See also *Waring v. W.D.A.S.*, 327 Pa. 433, 194 A. 631 (note 2, 194 A. 633-4) (Sup. Ct. Pa., 1937).

On the other hand, the broad patent monopoly arrests even independent creation. The measure of infringement is ultimate result, not the presence or absence of copying. It follows that the grant is appropriate or inappropriate in accord with the presence or absence of substantial change beyond the skill of the art. This is the invention concept which has been part of the Patent Law since at least 1850 and is now embodied in Section 103 of the Patent Code (Title 35, U.S.C.). Accordingly, the Patent Office must find invention before it is authorized to issue the grant. 35 U.S.C. 131.

In each instance the public is fully protected against improper issuance of the grant. The accused copyright infringer can always show that no work of art is involved. *Alfred Bell v. Catalda Fine Arts*, 191 F(2d) 99, 102 (C.A. 2, 1951). Similarly, the accused design patent infringer can attack the grant as not based on invention. *Frankart v. Apt Novelty Co.*, 57 F(2d) 757 (S.D.N.Y., 1931).

The differences between design patent, on one hand, and copyright, on the other hand, reflect more than historical accident. They recognize the futility of evaluating a work of art from the standpoint of the "prior art". It is absurd to seek "invention" in Verricchio's "David" as compared to Donatello's work of the same title a few years earlier (see 20 Encyclopedia Britannica opposite page 202, 1945 Ed.). Nevertheless each is a distinct work of art. Nor can one intelligently pursue the question of whether Rodin's "Thinker" is an invention over the millions of human

males that preceded the work. It is probably fair to say that the finer the art, the less applicable the concept of "invention". Congress wisely provided that works of art should be given limited protection based on their art and not upon irrelevant inquiries directed to the wholly inapplicable concept of "invention."

4. Speculations as to possible design patent protection cannot preclude copyright protection.—Even if we assume *arguendo* that the Design Patent Law covers the works here involved there is no inherent reason why they are not "works of art". To be sure, Respondents face the competition of nor-copyists by following the copyright route, but this does not alter the character of the works as embodying artistic craftsmanship. Neither the Copyright Law nor the Design Patent Law is in any respect restrictive. Neither refers to the other. Each sets forth its own requirements which, if met, qualify the work for registration. Indeed, the Copyright Code specifically states that the Register "shall" issue the certificate where there is compliance "with the provisions of *this title*". 17 U.S.C. 11.

The cases are clear that if a work qualifies for both copyright and design patent protection the creator can elect between the two types of protection but must abide by the election once made. These cases include:

Jones v. Underkoffler, 16 Fed. Supp. 729, 730 (M.D. Pa., 1936) (Cemetery memorial copyrighted as a "work of art." Held: Copyright valid and infringed by construction of a copied memorial. Defense that protection could only be procured under the Design Patent Law rejected because "... * * Such designs would accordingly appear both copyrightable and patentable." (quoting Weil on Copyright, p. 227))

In re Blood, 23 F(2d) 772 (App. D.C., 1927) ("* * * The applicant was entitled to apply for a patent for the design as a hosiery label, or he might complete the label, and register the design so completed. He could not do both. * * *")

DeJonge v. Breuker and Kessler, 182 Fed. 150 (C.C. E.D.Pa., 1900) ("* * * It clearly appears that the painting now in question is artistic in thought and execution, and it was therefore entitled to protection by a copyright, if a copyright was desired. It appears just as clearly that neither the artist nor his patron intended to reproduce the painting as such a work of art is ordinarily reproduced, but intended to multiply it as a design for a fancy paper to cover boxes and other articles for the holiday season. Nevertheless, when the painting left the artist's hand, it was of such a character as made it eligible either for copyright or for patent; at the option of the author or owner. * * *, 182 Fed. 150, 151).

Rosenthal v. Stein, 205 F(2d) 633, 635 (C.A. 9, June 26, 1953) ("The area in which a thing would be either a copyrightable work of art or a patentable design, but not the other, is perhaps unsurveyable. Whether a thing is a work of art or a patentable design, or is a patentable design and not a work of art, cannot be determined by excluding one from the other. A thing is a work of art if it appears to be within the historical and ordinary conception of the term art. A thing is a design by the same token. The two are not necessarily distinct one from the other. Neither goes to the functioning of a utility.'")

5. *Respondents' decision to obtain copyright and face the competition of other creators should be honored.*— Respondents believe the works here properly belong under the Copyright Law, not the Design Patent Law. They are statues of the human figure in action, a classic art form. They are wholly unlike industrial designs such as

hosiery which are prepared in the first instance to perform a function and then pleasing appearance is imparted to the extent the functional purpose will permit.

We have difficulty—shared by the courts—applying the word “invention” as used in the Design Patent Law to an object of art as distinguished from an industrial design. The Court of Customs and Patent Appeals has apparently disqualified the normal human figure—regardless of pose—from the scope of the Design Patent Law, for it has declared:

“The difference between what constitutes invention and a mere imitation of natural forms suggests itself in the gargoyles of architecture and the unicorn and dragons of the English and French heraldry. These abnormal forms might well constitute invention and be the subject of design patents, while mere imitation of reproductions of a normal horse or serpent or human face might not. It is a departure from the normal and usual which, in such cases, might constitute invention.” (*In re Smith*, 77 F(2d) 513, 514 (1935)).

See also *In re Smith*, 77 F(2d) 514, 515 (C.C.P.A., 1935) and *Frankart v. Apt Novelty Co.*, 57 F(2d) 757 (S.D.N.Y., 1931) (nude figure of girl not design patentable).

Surely Respondents are not to be penalized because they rely on the above decisions, the language of the Copyright Law, and the practice of the Copyright Office, to follow the copyright route rather than the design patent route. They accept the limitations of the copyright grant and willingly face the competition of those who create their own art. All they seek is protection from plagiarists—people who make molds from the artistic creations of others and sell them as their own and as “California Modern” rather than executing their own sculpture (Plf. Ex. 15, R. 40C;

17). Do Respondents seek too much? Must they "fall between two stools", as one commentator has expressed it, after having done their best to secure legal protection? Erenberg, Copyright No-Man's Land (1953) *Copyright Problems Analyzed* (C.C.H.) 215, 236.

Of one thing we can be sure. If we were before this court with design patents the Petitioners would here be arguing that copyrights should have been obtained instead.

D.

The Expert Case.

Stein v. Expert Lamp Co., 188 F(2d) 611 (C.A. 7, 1951), so heavily relied upon by Petitioners should not be followed. In the first place both the District Court and the Court of Appeals in that case misinterpreted the regulations of the Copyright Office. The District Court stated:

"* * * It is the court's opinion the phrase 'mechanical and utilitarian aspects' means that the plaintiff could have no monopoly on the mechanics of making the statuette and further could claim no monopoly on the use to which it could be put. The court is therefore of the opinion that the object under consideration is not copyrightable subject matter." (96 Fed. Supp. 97, 98)

The Court of Appeals, affirming this decision without modification, quoted the regulation in full as supporting the conclusion reached (188 F(2d) 611, 613).

The present record shows beyond all doubt that the position of Respondents here is entirely in accord with the practice of the Copyright Office and with the regulation quoted (R. 25-30).* Moreover, we have the testimony

* The interpretation by the Copyright Office of its own regulation is, of course, controlling. *Bowles v. Seminole Rock and Sand*, 325 U.S. 410, 414 (1945).

of the Register himself that the works here would be registered even if there were some indication of their use as parts of complete lamps (R. 29). Surely, the Court of Appeals for the Seventh Circuit would have reached a different conclusion had it properly construed the regulation of the Copyright Office and considered the long-standing practice of that Office with respect to registration of works of art having useful applications. In any event it is clear that the decision has little weight in relation to the contrary decisions of the Court of Appeals for the Fourth Circuit in the present cause and the Court of Appeals for the Ninth Circuit in *Rosenthal v. Stein*, 205 F(2d) 633 (June 26, 1953), both of which were based on a full understanding of the Copyright Office practice.

Perhaps most crucial of all, however, is the misplaced monopoly phobia applied in the *Expert* case. The court relied upon generalities respecting procedural differences and term of design patent and copyright—even considering the comparatively small fee required of the copyright applicant. Nowhere did the court consider—or even mention—the restricted character of the copyright grant and the broad design patent protection which affords a complete monopoly even as against independent inventors. Surely, the court would have concluded otherwise had it realized that all of this emphasis worked contrary to the conclusion reached rather than in support of it.

The *Expert* decision also ignores the history of the Copyright Law and Design Patent Law which shows that the Copyright Law was expanded in 1909 to cover all "works of art" and not just works of fine art.

Even more revealing is the treatment of the *Expert* case by the courts and commentators. We have already noted

that the case has been rejected by the Court of Appeals in the present cause and by the Court of Appeals in *Rosenthal v. Stein*, 205 F(2d) 633, (C.A. 9, June 26, 1953). The writers have been equally critical. Despite a plethora of comment, no one has spoken in support of the *Expert* case. Rather, all agree that utility—or possible utility—is beside the point and that the copyright to a statue is infringed by embodiment of a copy in a lamp. i.e. 27 *Indiana Law Journal*, 130, 134 (1951); 21 *George Washington Law Review*, 353, 366 (1953); 66 *Harvard Law Review*, 877, 884 (1953); 52 *Michigan Law Review* 33, 64, 68 (1953); Derenberg, Copyright No-Man's Land, (1953) *Copyright Problems Analyzed*, (C.C.H.) 215, 238, 246 (also printed at 35 Jl. Pat. Off. Soc. 627).

Moreover, the *Expert* case is distinguishable on its facts. There the District Court stated:

“* * * In plaintiff's reply brief it is asserted two models of the statuettes, one female and one male, were submitted to the copyright office and these models were in the ‘form of lamp bases having the threaded mounting stub to receive a lamp socket.’” (96 Fed. Supp. 97)

“It would seem that plaintiff's submission of the statuettes with the lamp mounting stubs to the copyright office was evidence of the practical use to which they were intended to be put. Had it been merely the statuette, use of the statuette thereafter in any practical manner would not remove it from the scope of copyright protection. Having submitted the statuette as a lamp base, thereby limiting the use of the statuette, plaintiff cannot monopolize such use under the copyright statu(t)e. * * *” (96 Fed. Supp. 98)

The Court of Appeals stated:

“The trial judge held that plaintiffs' submission of the statuettes with the lamp mounting stubs to the

Copyright Office was evidence of the practical use to which the statuettes were intended to be put, and that plaintiffs could not monopolize such use under the copyright statute." * * * (188 F(2d) 611, 612)

The trial judge later clinched this matter when, after the Court of Appeals decision, he stated:

"* * * The pertinent feature compelling the court to make the decision of January 23, 1951, was the submission to the copyright office of plaintiff's statuette 'having the threaded mounting to receive a lamp socket' * * * (107 Fed. Supp. 60, 61)

The copyrights in issue here were granted upon the basis of specimens submitted in the statue form without lamp mounting stubs (R. 21, Plf. Ex. 1A to 6A and 8, R. 15).* The *Expert* case is thus distinguishable.

The Copyright Law was expanded in 1909 to the broad term "works of art"—the Copyright Office has granted registrations to statuary irrespective of useful application since at least that date—Congress confirmed the Copyright Office practice in the 1947 Copyright Code and in the 1952 Patent Code as well as by leaving the law unchanged for over 40 years. In addition, copyright is a very narrow grant and wholly unlike the broad patent monopoly which is good against subsequent independent creators. Surely, the singular *Expert* decision—which has been rejected by two Courts of Appeal and by all the commentators—should not control the outcome of this cause.

* An affidavit in the *Expert* case showed that the deposits were like those in the present case but this affidavit was overlooked by both courts. The decision accordingly stands only as authority for what the courts actually did decide—the case with stubs. "Even if the court * * * misapprehends or mistakes the facts, the conclusion, to be of any value as a precedent, must be taken as applicable to the facts as assumed by the court; * * *." (14 Am. Juris. 289)

CONCLUSION.

For the foregoing reasons, we respectfully submit that the judgment below should be affirmed.

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